

### **REMARKS/ARGUMENTS**

This paper is submitted in response to the Office Action mailed February 9, 2006. At that time, claims 36-39 were withdrawn from consideration and claims 1-35 were pending in the application. In the Office Action, the Examiner objected to the specification and rejected claims 2 and 33 under 35 U.S.C. § 112. The Examiner also objected to claims 11 and 14. The Office Action rejected claims 1-3, 11, 14, 17-20, 22-23, and 33 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,811,181 issued to Hauer (hereinafter "Hauer"). Claims 12, 15, 29, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauer in view of U.S. Patent No. 5,303,952 issued to Shermetaro et al (hereinafter "Shermetaro"). Claims 4-10, 13, 16, and 24-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauer. Claims 21 and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauer in view of U.S. Patent No. 4,817,874 issued to Jarzebowicz (hereinafter "Jarzebowicz"). Claims 30 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauer, Shermetaro and in further view of JP 56038364 A to Ogawara et al (hereinafter "Ogawara"). Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauer.

By this paper, claims 1, 12, 15, 16, 23, 25, and 33 have been amended and claims 2, 11, and 14 have been canceled. Favorable consideration is respectfully requested.

#### **I. Specification**

The Examiner raised attention to the Abstract of the present application. By this paper, the Abstract has been amended. Favorable consideration is respectfully requested.

The Examiner also objected to the specification under 37 C.F.R. § 1.75(d)(1) as failing to provide proper antecedent basis for claim 25. At the same time, the Examiner also suggested a possible amendment to claim 25 that would overcome this objection. As a result of this paper, Applicants have amended claim 25 to incorporate the Examiner's suggestion. Withdrawal of this objection is respectfully requested.

#### **II. Rejection of Claims 2 and 33 Under 35 U.S.C. 112**

The Examiner rejected claims 2 and 33 as being indefinite. This rejection is respectfully traversed.

With respect to claim 2, the Examiner asserts that the recitation that the gasket is “ring-shaped” is unclear because the drawings show a gasket that “looks more like a square.” Although Applicants disagree with the Examiner’s rejection on this matter, Applicants have canceled this claim in order to further prosecution of this application. However, Applicants note that this cancellation of claim 2 is made for purposes of form and does not constitute (in any way) a surrender of subject matter related to the particular shape of the gasket. On the contrary, Applicants’ specification clearly teaches that the gasket may have a variety of different shapes within the scope of the present invention (including gaskets that are “ring-shaped,” “square-shaped,” and/or otherwise shaped). *See e.g.*, Specification, page 11, line 19 through page 12, line 6.

With respect to claim 33, the Examiner rejected this claim as lacking a proper antecedent basis for the term “foil strips.” As a result of this paper, claim 33 has been amended to correct this error. Withdrawal of this rejection is respectfully requested.

### **III. Objection to Claims 11 and 14**

The Examiner objected to claims 11 and 14 as being improper dependent claims. As a result of this paper, claims 11 and 14 have been canceled. Withdrawal of this objection is respectfully requested.

### **IV. Rejection of Claims 1-3, 11, 14, 17-20, 22-23, and 33 Under 35 U.S.C. 102(b)**

In the Office Action, the Examiner rejected claims 1-3, 11, 14, 17-20, 22-23, and 33 under § 102(b) as anticipated by Hauer. With respect to claims 2, 11, and 14, these claims have been cancelled. However, with respect to the remaining claims, this rejection is respectfully traversed.

It is well settled that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (*quoting Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Id.* (*quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, “the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in

possession of a person of ordinary skill in the field of the invention.” *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

In the present case, independent claims 1 and 23 have been amended to recite that “the first surface [is] above the second surface.” Support for this element is found throughout Applicants’ specification, including Figures 1-3. This claim element is not disclosed by Hauer. Specifically, as shown in Figure 1 of Hauer, the regions the Examiner asserts as comprising the claimed first and second surfaces are both positioned at the same height. Thus, Hauer clearly does not teach a gasket having a first surface that is above the second surface, let alone a gasket having a foil strip that is positioned with respect to the first and second surfaces as indicated by the independent claims. Thus, as all of the claimed elements are not found in Hauer, this reference cannot be used to anticipate independent claims 1 and 23 under § 102(b). Withdrawal of this rejection is respectfully requested.

With respect to dependent claims 3, 17-20, 22, and 33, these claims depend from either claim 1 or claim 23. Accordingly, these claims are similarly patentable over Hauer for the reasons explained above. Withdrawal of these rejections is respectfully requested.

**V. Rejection of Dependent Claims Under 35 U.S.C. 103 (a)**

In the Office Action, the Examiner rejected claims 12, 15, 29, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Hauer in view of Shermetaro. Claims 4-10, 13, 16, and 24-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauer. Claims 21 and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauer in view Jarzebowicz (hereinafter “Jarzebowicz”). Claims 30 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauer in view of Shermetaro and in further view of Ogawara. Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauer. These rejections are respectfully traversed.

It is well settled that a claim cannot be rejected under § 103(a) unless each and every claim element is taught or suggested by the prior art references. *See* MPEP § 2143.03. As noted above, all of the pending dependent claims depend from either independent claim 1 or independent claim 23. As noted above, these independent claims recite the claim feature that “the first surface being disposed above the second surface.” This claim feature is not, as

explained above, taught or suggested by Hauer. Likewise, Applicants submit that none of the other cited references (Shermetaro, Jarzebowicz, or Ogawara) teach or suggest this feature. Thus, because this claim feature is not taught or suggested by the cited references, these dependent claims cannot be rejected under § 103(a). Withdrawal of all of these rejections is respectfully requested.

**VI. Conclusion**

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



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